Group II: claims 1, 2, 12, and 25-29, drawn to a method for promoting neuronal regeneration and/or growth in an animal comprising administering to said animal an effective amount of a compound of formula II;

Group III: claims 1, 2, 12, and 33-37, drawn to a method for stimulating the growth of at least one damaged peripheral nerve in an animal comprising administering to said damaged peripheral nerve an effective amount of a compound of formula II; and

Group IV: claims 1, 2, 12, 41-45 and 49, drawn to a method for stimulating neurite outgrowth by a nerve cell in an animal comprising administering to said nerve cell an effective amount of a compound of formula II

Applicants elect to prosecute Group IV, claims 1, 2, 12, 41-45 and 49, with partial traverse with respect to the way the claims are grouped. In particular, Applicants believe that claims 2 and 12 should not be included in Group IV. Claims 2 and 12 are limited to methods for stimulating the growth of damaged neurons, promoting neuronal regeneration, treating a neurological disorder, and preventing neurodegeneration. According to the Examiner, these methods are different from the claims of Group IV, which recite methods for stimulating neurite outgrowth by a nerve cell.[1] Because claims 2 and 12 do not recite a method for stimulating neurite outgrowth by a nerve cell, those claims are believed to be incorrectly included in Group IV.

Additionally, Applicants wish to clarify that, with the exception of claim 1, none of the claims in Group IV state that the neurite outgrowth by a nerve cell is *in an animal*.

Moreover, claim 1, which is a member of all four Groups identified by the Examiner, appears to be a linking claim as described in M.P.E.P. § 809.03. As such,

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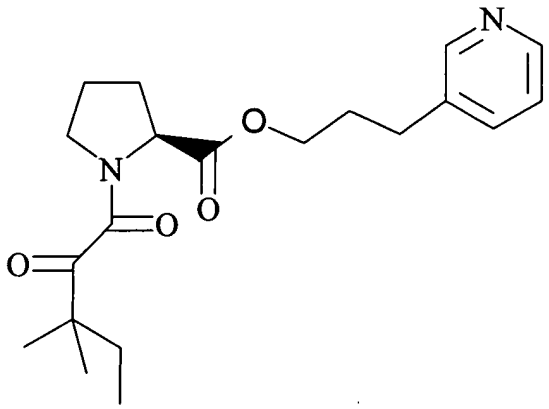
[1] Applicants contend that, to the extent the Examiner is correct that Groups I-III recite different inventionsa from that encompassed by Group IV, the methods of Group IV are also a different invention from methods for preventing neurodegeneration.

the restriction requirement between the linked inventions should be **subject to** the nonallowance of claim 1. *See* M.P.E.P. § 809.03. Upon allowance of claim 1, the requirement for restriction between Groups I-IV should be withdrawn and all of the claims should then be examined. *See id.*

For the reasons above, Applicants respectfully request the reconsideration and correction of the restriction requirement.

The Examiner also required election under 35 U.S.C. § 121 of a single disclosed neuroimmunophilin species. Applicants provisionally elect 3-(3-pyridyl)-1-propyl (2*S*)-1-(3,3-dimethyl-1,2-dioxopentyl)-2-pyrrolidinecarboxylate (Example 24) with traverse:



All of the claims in Group IV read on this species.

Applicants respectfully note that the Office has concluded several times that the immunophilin species encompassed by Formula II are not patentably distinct. For example, claims 1 and 4 of U.S. Patent No. 5,614,547 ("the '547 patent") to Hamilton et al. encompass a genus of compounds that is virtually coextensive with the genus of Formula II. The instant application is a continuation-in-part of the '547 patent. Similarly, claim 4 of U.S. Patent No. 6,124,328 ("the '328 patent) to Armistead et al. encompasses a genus of compounds that is virtually coextensive with the genus of Formula II. Applicants noted this fact as required by 37 C.F.R. § 1.607 in the Transmittal Letter filed

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with the instant application and provided a direct comparison of claim 4 with the instant claims in the Request Under 37 C.F.R. § 1.607 That an Interference Be Declared, which was filed April 19, 2002.

The M.P.E.P. is clear that "**Election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other.**" M.P.E.P. § 808.01(a) (emphasis original). Here, having already issued at least two patents with claims encompassing the genus of Formula II, the Office cannot credibly assert that, if it were to find any species within Formula II unpatentable over the prior art, it would not insist that all species within Formula II were equally unpatentable. Under these circumstances, requiring Applicants to elect a single species for examination is inappropriate.

Applicants request the reconsideration and withdrawal of the species election requirement.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: April 28, 2003

By: 
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